

REMARKS

Claims 1-9 and 22-24 are pending in the application. Claims 10-21 have been withdrawn following the restriction requirement of November 20, 2003. This Amendment cancels claims 7-9 without prejudice or disclaimer. Claims 1-3, 6, and 24 are currently amended. Claims 4, 5, and 22-23 are as originally presented. A copy of the claims now pending in the application in accord with 37 CFR 1.121, as revised, has been provided.

Without prejudice and in the interests of clarity and of facilitating prosecution applicants have made the following amendment to the claims. Applicants reserve the right to file claims on the unclaimed subject matter in subsequent applications.

In accordance with the restriction requirement, Applicants have amended claim 1 to embrace compounds of formula I wherein X is phenyl or naphthalene.

Applicants have amended claim 1 to recite that a substituent on the phenyl or naphthalene rings of the Z group be selected from a group consisting of halogen, -OH, -CF₃, -NO₂, -NH₂, -NH(C₁-C₆alkyl), N(C₁-C₆alkyl)₂, C₁-C₆ alkyl, -OC₁-C₆ alkyl, -CN, -CF₃, -CO₂H, and CO₂C₁-C₆ alkyl. Support for this amendment can be found at page 11, line 25 to page 12, line 4.

Applicants have also amended claim 1 to recite that R¹ may be C₁ -C₈ alkyl and that R² may be C₄ -C₈ alkyl which is clearly supported in the original recitation that R₂ C₁-8. Further support for this amendment can be found e.g. in originally filed claims 2 and 3 and at pages 20-36 of the specification as filed. Therein, numerous examples which support the claimed structural aspects as amended, including without limitation the following:

- (Z) [5-(4-Diisobutylamino-benzylidene)-4-oxo-2-thioxo-thiazolidin-3-yl]-acetic acid;
- (Z) [5-(4-Dipentylamino-benzylidene)-4-oxo-2-thioxo-thiazolidin-3-yl]-acetic acid;
- (Z) {5-[4-[Bis-(3-methyl-butyl)-amino]-benzylidene]-4-oxo-2-thioxo-thiazolidin-3-yl}-acetic acid;
- (Z) [5-(4-Dihexylamino-benzylidene)-4-oxo-2-thioxo-thiazolidin-3-yl]-acetic acid;
- (Z) {5-[4-(Hexyl-methyl-amino)-benzylidene]-4-oxo-2-thioxo-thiazolidin-3-yl}-acetic acid;
- (Z) {5-[4-(Butyl-methyl-amino)-benzylidene]-4-oxo-2-thioxo-thiazolidin-3-yl}-acetic acid;
- (Z) {5-[4-(Butyl-ethyl-amino)-benzylidene]-4-oxo-2-thioxo-thiazolidin-3-yl}-acetic acid.

In view of the amendments made herein and the remarks below, applicants respectfully request reconsideration and withdrawal of the rejection set forth in the August 26, 2004 office action.

Rejection under 35 USC § 112, second paragraph

Claim 1 stands rejected as indefinite because the claim term "substituted", as applied to phenyl and naphthyl rings, is allegedly unclear as to its intended scope. In view of the amendment to claim 1 further defining the claim term "substituted", Applicants respectfully request that the aforementioned rejection for indefiniteness be withdrawn.

Claims 6, 9 and 24 stand rejected as allegedly indefinite because the claims recite "compound of claim 4", wherein claim 4 is a method claim. Applicants note that claim 9 has been cancelled. Applicants have amended claims 6 and 24 to recite "compound of claim 2". Support for this amendment can be found at page 20, line 5 to page 23, line 11, and at page 36, line 4 to line 25. In view of the foregoing remarks and amendments Applicants respectfully request that the aforementioned rejection for indefiniteness be withdrawn.

Claims 7-9 stand rejected as allegedly indefinite for multiple reasons. In view of the fact that claims 7-9 have been cancelled, Applicants request that these rejections be withdrawn.

Rejection under 35 USC § 112, first paragraph

Claims 7-9 stand rejected because they are allegedly not enabled. In view of the fact that claims 7-9 have been cancelled, Applicants request that these rejections be withdrawn.

Rejection under 35 USC § 102 (b)

Claims 1 and 2 stand rejected as anticipated by U.S. Patent No. 4,885,369 ("Uryu"). It is alleged that Uryu refers to a phenyl diethyl amine species embraced by originally filed claims 1 and 2. Without acquiescence, as amended claims 1 and 2 do not embrace the diethyl amine species of Uryu. Therefore, Applicants respectfully request that the aforementioned rejection for anticipation be withdrawn.

Claims 1 and 2 stand rejected as anticipated by EP Patent No. 0047109 ("Tadao"). It is alleged that Tadao discloses a phenyl dimethyl amine species embraced by originally filed claims 1 and 2 (i.e. compound 14). Without acquiescence, as amended claims 1 and 2 do not embrace the dimethyl amine species of Tadao. Therefore, Applicants respectfully request that the aforementioned rejection for anticipation be withdrawn.

Rejection under 35 USC § 103 (b)

Claims 2-3 and 22-23 stand rejected as obvious over Tadao. The Official Action alleges that the specific compounds of the claims would have been obvious because they are higher homologs of the dimethyl amine substituent of compound 14 and because Tadao discloses a genus which embraces the higher homologs. Thus, the Examiner has argued that in view of the

genera disclosed by Tadao, it would have been obvious to replace the methyl groups compound 14 with ethyl, propyl and butyl groups to arrive at the compounds of claims 2-3 and 22-23.

Applicants respectfully disagree with the Examiner's position because Tadao supplies no motivation to make the specific species recited in claims 2-3 and 22-23.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP 2142*.

The patentability of a claim to a specific compound or subgenus embraced by a prior art genus should be analyzed no differently than any other claim for purposes of 35 U.S.C. 103. *MPEP 2144.08*. The fact that a claimed species or subgenus is allegedly encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. *MPEP 2144.08 II*. Some motivation to select the claimed species or subgenus must be taught by the prior art. *MPEP 2144.08 II A. 4. (a)*.

As a preliminary matter Applicants note that, as amended claims 2-3 and 22-23 do not embrace compound 14 of Tadao.

Applicants further note that Tadao purports to describe a very large genus comprising thousands, if not tens of thousands, or even more individual species. The R2 group of Tadao, in point, embraces far too many permutations and combinations to meaningfully motivate the reader in any one direction, much less to that which is claimed herein, e.g., R2 includes *inter alia*, a cycloalkyl or cycloalkenyl of 4-7 carbon atoms, an anthryl or naphthyl group, and a phenyl substituted with a halogen, a hydroxyl group, a carboxyl group or an alkyl or alkylthio group of 1-5 carbon atoms.

There is primarily no motivation whatsoever from Tadao to lead one of ordinary skill in the art to make the specific species recited in claims 2-3 and 22-23. Rather one would only arrive at these specific compounds from Tadao by the use of impermissible hindsight.

Thus, in view of the fact that Tadao does not supply motivation to make the specific compounds recited in claims 2-3 and 22-23, Applicants respectfully request that the obviousness rejection be withdrawn.

Claims 1-9 and 22-24 stand rejected as obvious over U.S. Patent No. 5,523,314 ("Bue-Valleskey"). As noted above claims 7-9 have been canceled and are no longer at issue.

Bue-Valleskey pretends to describe an extraordinarily large genus of compounds. But critically, there are no guideposts that would lead to the modifications needed to bear on the compounds claimed herein. Indeed, the compounds 82 and 86 relied upon by the Examiner,


have multiple and various differences with those embraced by amended claims 1-9 and 22-24. Compounds 82 and 86 do not in combination result in a compound embraced by the claims. There is thus no motivation to combine compounds 82 and 86, much less motivation to make the further changes required to arrive at the subgenus and species embraced by claims 1-9 and 22-24. Thus, Applicants respectfully request that the obviousness rejection over Bue-Valleskey be withdrawn.

CONCLUSION

In view of the amendments set forth herein and remarks above, the applicants respectfully submit that the pending claims are fully allowable, and solicit the issuance of a notice to such effect. If a telephone interview is deemed to be helpful to expedite the prosecution of the subject application, the Examiner is invited to contact applicants' undersigned attorney at the telephone number provided.

The Commissioner is hereby authorized to charge any fees required under 37 C.F.R. §§1.16 and 1.17 or to credit any overpayment to Deposit Account No. 16-1445.

Date: November 19, 2004


John Resek
Attorney for Applicant(s)
Reg. No. 52,162

Pfizer Inc
Patent Department
150 East 42nd Street – 5th Floor
New York, NY 10017-5755
(212) 733-3381